

ESTTA Tracking number: **ESTTA727382**

Filing date: **02/16/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86447383
Applicant	Mannatech, Incorporated
Applied for Mark	NUTRIVERUS
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Date	02/16/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re:	Trademark Application of Mannatech, Incorporated	§ § §	Law Office:	116
Serial No.:	86/447,383	§ § §	Examining Attorney:	Tamara Frazier
Filed:	November 6, 2014	§ §	Attorney Docket No.:	1002.0006
For:	NUTRIVERUS & Design	§		

The logo for NutriVerus, featuring the word "Nutri" in a standard sans-serif font and "Verus" in a stylized font with a large, sweeping arch over the "V".

APPLICANT'S APPEAL BRIEF

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In re:	Trademark Application of Mannatech, Incorporated	§ § §	Law Office:	116
Serial No.:	86/447,383	§ § §	Examining Attorney:	Tamara Frazier
Filed:	November 6, 2014	§ §	Attorney Docket No.:	1002.0006
For:	NUTRIVERUS & Design	§		



APPLICANT'S APPEAL BRIEF

Mannatech, Incorporated (hereinafter "Applicant") hereby submits its Appeal Brief.

I. DESCRIPTION OF THE RECORD

Applicant seeks to register the mark NUTRIVERUS & Design on the Principal Register for *dietary supplements and nutritional supplements sold through a multi-level marketing program.*

II. STATEMENT OF THE ISSUES

The Examining Attorney refused registration of the mark NUTRIVERUS & Design (hereinafter "Applicant's Mark") under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that Applicant's Mark is confusingly similar to United States Registration No. 3,774,292 for NU VERUS & Design.

III. RECITATION OF THE FACTS

On November 6, 2014, Applicant filed application serial number 86/447,383 to register the mark NUTRIVERUS & Design on the Principal Register for *dietary supplements and nutritional supplements* in International Class 5.

The Examining Attorney issued an initial Office Action on December 31, 2014 refusing registration of Applicant's Mark under Section 2(d) of the Trademark Act citing United States Trademark Registration No. 3,774,292 for NU VERUS & Design. On April 14, 2015, Applicant filed a response to the office action submitting that no likelihood of confusion existed.

On May 13, 2015, the Examining Attorney issued a Final Office Action maintaining refusal of Applicant's Mark over NU VERUS & Design. Applicant filed a response on November 13, 2015 to the office action furthering its argument that no likelihood of confusion existed between Applicant's Mark and NU VERUS & Design.

The present Appeal is in response to the Final Office Action of May 13, 2015. Applicant respectfully requests that the Board reverse the refusal based on prior submissions and on the arguments below. Applicant submits that the cited mark at issue is unlikely to cause confusion with Applicant's Mark due to their inherent differences and different channels of trade. Accordingly, Applicant respectfully requests that the Section 2(d) refusal be withdrawn and the subject application approved for publication.

IV. ARGUMENT

Applicant's Mark, NUTRIVERUS & Design, should be approved for publication because (A) the cited mark is sufficiently different from Applicant's Mark; (B) the dissimilarity of the goods and channel of trade for each mark is such that no likelihood of confusion exists; (C) the

sophistication of purchasers is such that no likelihood of confusion exists; and (D) the number and nature of similar marks

A. Comparison Must Be Based on the Marks in Their Entireties

A mark should not be dissected or split up into component parts and each part then compared with the corresponding parts of the conflicting mark to determine the likelihood of confusion.

To begin, the Examiner misapplied controlling law by improperly dissecting Applicant's Mark for comparison against NU VERUS & Design for likelihood of confusion. The Examiner has no right to dissect Applicant's Mark into two terms "NUTRI" and "VERUS" when the mark itself forms a single, fanciful, new word, "nutriverus", and should be viewed as a whole. The Federal Circuit has long prohibited an analysis that dissects the marks rather than considers them as a whole. *See, e.g., China Healthways Inst., Inc. v. Xiaoming Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007). This fundamental error made by the Examiner taints her entire analysis, as the Examiner's ultimate decision builds from this flawed analysis. As such, this error resulted in the Examiner miscalculating the *DuPont* balance in rendering her decision.



A mark cannot not be dissected into its various components and considered in detail; instead, a mark must be considered as a whole in determining the likelihood of confusion. *See Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920) ("The commercial

impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015) (citing *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)) (emphasizing the similarity of marks should be compared in their “entireties as to appearance, sound, connotation and commercial impression.”); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (“[I]t merely requires heeding the common-sense fact that the message of a whole phrase may well not be adequately captured by a dissection and recombination.”); *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (“[M]arks must be viewed 'in their entireties,' and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design.”); *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 1340, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (“It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.”); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

In failing to assess the full impression created by NUTRIVERUS & Design in the manner required by Federal Circuit precedent, the Examiner committed legal error. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). When the marks are viewed in their entireties, the commonality of the word “VERUS” is not enough to conclude that there will be a likelihood of confusion. Accordingly, the Examiners analysis is improper for dissecting Applicant’s Mark to compare against NU VERUS & Design for likelihood of confusion; to conclude the dominant portion of Applicant’s Mark is “VERUS”; and to conclude the term “NUTRI” is descriptive. The

term NUTRIVERUS, however, is fanciful cannot be dissected into two terms, nor is one portion of the mark more dominant than the other.

Moreover, the Examiners analysis is also inadequate and fails to apply controlling law. The Examiner's analysis fails to display any consideration of how the single word, NUTRIVERUS, may convey a distinct meaning—including by having different connotations in consumer's minds—from the two word design mark, NU VERUS & Design. Although the Examiner contends the marks have been considered in their entirety, the Examiner fails to provide further reasoning for such consideration in her analysis. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000)) (“To be sure, the Board stated that it had considered the marks in their entirety. But this statement, absent further explanation of the agency's reasoning, is simply insufficient for proper review of PTO fact finding.”).

1. “NUTRIVERUS” is a fanciful mark

NUTRIVERUS forms a new word, moreover, a fictitious term that cannot be defined. *See Lane Capital Mgmt. v. Lane Capital Mgmt.*, 192 F.3d 337, 344 (2d Cir. 1999) “(A fanciful mark is not a real word at all, but is invented for its use as a mark.”); *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 391 (2d Cir. 1995) (“A fanciful mark is a made-up term.”); TMEP § 1209.01(a) (“Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, and EXXON) or are completely out of common usage (e.g., FLIVVER).”).

2. “NUTRI” Is Suggestive

In improperly dissecting Applicant's Mark, the Examiner incorrectly concluded that the term "NUTRI" is "descriptive" or "less significant" than the term "VERUS". To the contrary, the term "NUTRIVERUS", when considered in its entirety, is suggestive and cannot be dissected into two terms. *See China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 1340, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) ("It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue."). *See, e.g., Am. Home Products Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 106 (2d Cir. 1978) (finding "Roach Motel" to be suggestive when viewed in its entirety due, in part, to the incongruity of the mark); *W. & Co. v. Arica Inst., Inc.*, 557 F.2d 338, 342 (2d Cir. 1977) (holding the term "'psycho-calisthenics'" as suggestive rather than merely descriptive); *W. G. Reardon Labs., Inc. v. B. & B. Exterminators, Inc.*, 71 F.2d 515 (4th Cir. 1934) (holding the mark "Mouse Seed," when viewed in its entirety, creates an element of incongruity that makes the mark unusual and unique and thus not descriptive). By characterizing "NUTRI" as descriptive, the Examiner disregards the legal relevance of this term—this word in conjunction with the rest of the mark connotes an entirely different appearance, sound, connotation, and imagery for the consumer.

"NUTRIVERUS" forms a new word, which creates an incongruity, and thus results in an overall suggestive trademark, at the very least. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004) (citing *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998) ("These creative marks [fanciful, arbitrary, or suggestive] are distinguished from descriptive marks, which 'define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood.'"); *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995) (emphasizing the fact that if the mental leap between the word and the product's attributes is not almost instantaneous, this strongly indicates suggestiveness, not descriptiveness);

Investacorp, Inc. v. Arabian Inv. Banking Corp., 931 F.2d 1519, 1523 (11th Cir. 1991) (“A suggestive term suggests the characteristics of the service and requires an effort of the imagination by the consumer in order to be understood as descriptive of the service.”); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) (“If a consumer must use more than a small amount of imagination to make the association [of product attribute], the mark is suggestive and not descriptive.”); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980) (“A mark is merely descriptive if it immediately conveys to one seeing or hearing it knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used; whereas, a mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services.”); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 379 (7th Cir. 1976) (in distinguishing between suggestive and descriptive marks, “incongruity” between a purported mark’s ordinary meaning and its use in relation to a specific product is a strong indication of non-descriptiveness).

Accordingly, the word “NUTRIVERUS” does not convey an immediate idea of the ingredients, qualities, or characteristics of Applicant’s goods or services to consumers. Instead, “NUTRIVERUS” requires imagination, thought, and perception on behalf of consumers to reach a conclusion as to the nature of Applicant’s goods. As a result, the Examiner cannot easily discount the term “NUTRI” as if it is merely descriptive. Therefore, Applicant’s Mark, as dissected by the Examiner, is suggestive at least, and as stated should be considered as fanciful. Regardless of the mark being suggestive or fanciful, the fact remains that “NUTRI” is not descriptive.

B. Differences Between the Marks in Their Entireties

The Examiner erred by not giving meaningful legal weight to the differences in in appearance, sound, connotation, and commercial impression in her similarity analysis. Contrary

to the Examiner's analysis, the existence of a likelihood of confusion must be determined on the basis of all evidence viewed in its entirety. Here, NUTRIVERUS & Design is different in appearance, sound, connotation, and commercial impression when compared as a whole, which is precisely what makes the NUTRIVERUS & Design legally distinct from the cited mark.

First, the overall look and appearance of NU VERUS & Design is considerably different than Applicant's Mark. NU VERUS & Design is registered to distinguish a source of goods tied to the color claim, thereby limiting the mark's use to green and black color design shown in the registration. Moreover, the pictorial representation of NU VERUS & Design is so highly stylized, both in color and design, that it would not readily evoke in a purchaser's mind the words "NU VERUS". The word "NU" clearly stands out in bold lettering and is attached to a large, distinctive design of a mortar and pestle, whereas the word "VERUS" is independent and in over 75% smaller lettering, as shown in EXHIBIT 1 of Applicant's November 13, 2015 Final Office Action response. Thus, the term "VERUS" is inherently diluted and weaker in force.

Contrary to the Examiner's conclusion, the dominant portion of NU VERUS & Design is not the term "VERUS." *See Gen. Baking Co. v. Gorman*, 295 F. 168, 172 (D.R.I. 1924) ("A finding of a similar word in two trade-marks, however, does not establish the fact that this is a 'dominant feature.'"); *Peter Pan Founds., Inc. v. Beau-Bra Founds., Inc.*, 125 F. Supp. 637 (S.D.N.Y. 1954). Instead, the dominate feature of NU VERUS & Design is the mortar and pestle design in connection with the term "NU." Unlike a word mark, which can take any form of design, NU VERUS & Design is permanently tied to the claimed design. This means the term "VERUS" will always be diluted and the term "NU" and the mortar and pestle design will always be the most prominent and dominant portions of the mark, as demonstrated in aforementioned EXHIBIT 1.

Moreover, the color black of the mark's background is also a dominant feature of the mark, as the "background" is the largest portion of the mark and has not been limited to size. *See* EXHIBIT 3 of Applicant's Final Office Action Response (Registrant's own specimen demonstrating how the background is infinite). Thus, the black background is prominent and dominant in comparison to the words "NU" and "VERUS."

In contrast, NUTRIVERUS & Design includes a pictorial representation of a plant in place of the letter "V." Moreover, the dominant portion of Applicant's Mark remains "NUTRIVERUS," not "VERUS," as the Examiner improperly concluded. Accordingly, the dominant features of NU VERUS & Design and NUTRIVERUS & Design are noticeably different. As NU VERUS & Design is limited to the specific design, a consumer would not confuse the word portions of "NU" and "VERUS" with the Applicant's Mark due to the dominant placement of the term "NU" with the mortar and pestle design along with the overall blanketed background color of black. Therefore, the design and color of NU VERUS & Design as a whole is not confusingly similar to the mark NUTRIVERUS & Design.

Second, the overall sound for each mark is dissimilar. The words in neither NU VERUS & Design nor Applicant's Mark are pronounced the same when compared in their entireties. The Examiner gave the term "TRI" no meaningful legal weight in its similarity analysis. The term "TRI" in Applicant's Mark adds a syllable when spoken aloud, making the marks considerably different in sound. *See A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 217 (3d Cir. 2000) (noting that although the marks shared the same term "miracle," the marks had a different number of syllables, thereby supporting the District Court's ultimate conclusion that the marks are dissimilar); *Fancaster, Inc. v. Comcast Corp.*, 832 F. Supp. 2d 380, 412 (D.N.J. 2011) (noting that although both marks shared the same word "fancast," the applicant's mark contained

an extra syllable, thereby supporting the contention that the sound of the marks is somewhat distinct) .

Third, each mark contains additional elements to convey different connotations. Registrant willingly dissects their mark into two words “NU” and “VERUS,” as evidenced by Registrant’s design itself. Further, the design element of the NU VERUS & Design mark adds a prominent mortar and pestle to add to the connotation of the mark. The Examiner has failed to recognize the overall connotation of the design made by the very prominent design and the two separate “NU” and “VERUS” in applying the mark against the Applicant’s mark. Each mark forms a separate connotation and commercial impression, when not improperly dissected by the Examiner.

Finally, in terms of overall commercial impression, the dissimilarities between the marks, specifically in appearance, sound and connotation, when viewed in their entireties, create a substantially different commercial impression. *See Estate of P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 545-46, (1920) (“The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value”).

The Examiner also erred by finding limited probative value in the additional elements of each mark that convey different commercial impressions. Applicant’s Mark contains a plant and a new word, whereas the Cited Mark contains a color claim, mortar and pestle and two separate words “NU” and “VERUS”. As stated, NU VERUS & Design creates a separate impression from Applicant’s Mark in that NU VERUS & Design has incorporated color. *See* TMEP § 1202.05(c) (“As with all trademarks and service marks, a color mark may contain only those elements that make a separable commercial impression. *See* TMEP 807.12(d). Accordingly, an applicant may

not seek to register the color of the wording or design apart from the words or designs themselves if the color does not create a separate commercial impression. However, the applicant may register the color of the background material on which the words or design appear apart from the words or design.”). Moreover, the sheer size of the term “NU” and the mortar and pestle design impress a greater commercial impression on the consumer as opposed to the term “VERUS.” Thus, if the term “NU” or the mortar and pestle design were removed from the mark, the commercial impression would be greatly changed.

Accordingly, NU VERUS & Design is inherently different from Applicant’s Mark, with respect to commercial impression, because Registrant’s mark is so highly stylized, both in color and design, as previously discussed. In contrast, Applicant’s Mark depicts a plant in the place of the “V” and forms an entire, whole, new word which suggests “fighting nutrition.” *See* EXHIBIT 2 of Applicant’s Final Office Action Response; EXHIBIT B of Applicant’s Non-Final Office Action Response of April 14, 2015. Thus, Applicant’s Mark creates both a separate connotation and distinct commercial impression that aide a consumer to naturally identify the Applicant as the source of the goods being offered.

TMEP 1207.01(b)(i) states:

The points of comparison for a **word mark** are appearance, sound, meaning, and commercial impression. *See Palm Bay Imports., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005 (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)). **Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related; rather, taking into**

account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar. See *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

The Examiner is focused on the marks as if they were both word marks, when in fact, they are design marks. The previous paragraphs demonstrate how the Examiner did not take in to account ALL the relevant facts and differences between the marks.

C. Dissimilarity of Goods and Channel of Trade

Importantly, the likelihood of confusion between NU VERUS & Design and Applicant's Mark is obviated by the dissimilarity of the goods and channels of trade associated with the marks. In making a likelihood of confusion determination, the goods are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 U.S.P.Q. 638 (T.T.A.B. 1984).

The Examiner further erred by not giving proper weight to the differences in channels of trade between the NU VERUS & Design and Applicant's Mark. Applicant's application specifically limits its channels of trade to dietary and nutritional supplements sold through a multi-level marketing program. As such, Applicant's Mark is used on goods that are only sold through a multi-level marketing program, whereby independent distributors and company sponsors specifically educate and market the products to consumers, making the avoidance of any confusion inherent. Therefore, consumers would not assume that the goods from a common source as they could not be marketed and sold together and/or in the same channels of trade.

Although Registrant's website also suggests that Registrant is a multi-level marketing program, the goods would never appear side by side on a store shelf nor would either company's goods appear for sale with the multitude of samples from retailers. *See* EXHIBIT 4 from Applicant's Final Office Action Response. Even assuming *arguendo* that any potential overlapping marketing channels occurs over the Internet via marketing, the Ninth Circuit, however, has held that "it would be the rare commercial retailer that did not advertise online, and the shared use of a ubiquitous marketing channel does not shed much light on the likelihood of consumer confusion." *Network Automation, Inc. v. Advanced Sys. Concepts*, 638 F.3d 1137, 1151 (9th Cir. 2011) (citing *Playboy Enterprises, Inc. v. Netscape Commc'ns Corp.*, 354 F.3d 1020, 1028 (9th Cir. 2004) ("Given the broad use of the Internet today, the same could be said for countless companies. Thus, this factor merits little weight.")). *See also Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1151 (9th Cir. 2002) ("Some use of the Internet for marketing, however, does not alone and as a matter of law constitute overlapping marketing channels.").

D. Sophistication of Purchasers

The Examiner's analysis is further flawed with respect to source confusion and the sophistication of purchasers. The Examiner boldly asserts, "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion." The Examiner, however, misconstrues the cited quotation to encompass an overly broad application. Under the Examiner's analysis, source confusion would be inevitable for all marks, regardless of the purchaser's sophistication or knowledge or even whether or not the products were substantially identical. To the contrary, previous applications of this cited quote have been limited to such instances where the marks were substantially identical and the goods were related. *See In re Total*

Quality Group, Inc., 1999 TTAB LEXIS 127, 51 U.S.P.Q.2D (BNA) 1474 (Trademark Trial & App. Bd. Mar. 23, 1999) (“[E]ven careful purchasers are not immune from source confusion. We find this to be especially the case here where the marks are substantially identical and the goods are related.”); *In re Linkvest, S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re TIE/Communications Inc.*, 5 USPQ2d 1457 (TTAB 1987); *In re Graphics Technology Corp.*, 222 USPQ 179 (TTAB 1984). As previously discussed (*see supra* Part IV.A-C), NUTRIVERUS & Design **is not substantially identical** to the cited mark, thus, sophistication of purchasers, in conjunction with the care that purchasers exercise in selecting the particular goods, can reduce the likelihood of source confusion.

The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing also plays a determining factor in the conclusion that the marks are dissimilar. The sophistication of purchasers, coupled with the expense of the goods and care that purchasers exercise in selecting the particular goods, can reduce the likelihood of confusion and result in the registration of what otherwise might be similar marks. See *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841, 1844 (T.T.A.B. 1998) (“DIGIRAY” and “DIGIRAD” not likely to be confused, primarily due to sophistication of consumers and care that consumers displayed in purchasing goods); *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 717 (C.C.P.A. 1992) (“EDS” and “E.D.S.” not likely to cause confusion due primarily to sophistication of purchasers and care with which consumers purchase both parties’ goods).

As previously stated (*see supra* Part IV.C), each party sells their respective goods through distributors/sponsors via a multi-level marketing program, consumers are well educated in the source of the goods as well as the product lines prior to making a purchase. The decision to purchase these goods is not made in haste, thus greatly reducing the likelihood of confusion. The

procurement of these types of goods requires considerable thought, research, and deliberation as the consumer is making a conscious effort to improve their health.

E. Number and Nature of Similar Marks

The Examiner also committed legal error by improperly dismissing Applicant's previously submitted evidence demonstrating the number and nature of similar marks in use on similar goods/services. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1374, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (reiterating the fact that the Federal Circuit has held that evidence of third-party registrations is relevant to show that a segment of a mark "may have a 'normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.'").

The number and nature of similar marks in use on similar goods/services may be relevant in an ex parte likelihood-of-confusion determination and must be considered if there is pertinent evidence in the record. *See* TMEP § 1207.01(d)(iii)) ("...third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. V. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983)."). Applicant submitted a list of trademarks for the same goods using the term "NUTRI" for supplements, vitamins and other health products. None of the marks disclaimed the term "NUTRI" as being descriptive. In the Examiner's Denial for Request for Reconsideration, the Examiner

states: “However, all but one of the referenced examples third party registrations are one-word. As such, ‘nutri’ would not need to be disclaimed in such cases.” By the Examiner’s own admission, “NUTRI” should not be disclaimed or dissected. Therefore, “NUTRI” is not descriptive, as claimed by the Examiner in previous actions. Further, these prior registrations demonstrate single words, and cannot be dissected. Thus, “NUTRIVERUS” cannot be dissected. The Examiner’s own admission supports Applicant’s arguments that NUTRIVERUS creates a new, fanciful word and that at least the NUTRI portion is suggestive. The Examiner further disregards the list of prior registrations in the Final Office Action where she notes: “Nonetheless, the majority of the examples referenced by the applicant contain the term “NU”/“NUTRI” and are combined with highly suggestive/descriptive wording. However, the marks at issue share the very similar wording “NU”/“NUTRI” combined with the common identical *arbitrary* wording “VERUS”. The Examiner overlooked several of the prior registrations containing arbitrary terms such as “BEARS”, “GREEN”, “SOURCE”, “TEK”, and “ONE”. Her argument is invalid as “NU/NUTRI” marks coexist with arbitrary terms, such as “VERUS”.

Moreover, Applicant’s introduction of third party uses also demonstrates that customers have become so conditioned by a plethora of such similar marks that customers “have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1374 (Fed. Cir. 2005). A mark that is hemmed in on all sides by similar marks on similar goods or services cannot be “distinctive” because it is merely one of a crowd of similar marks. J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:85 (4th ed. 2001). In such a crowd, consumers will not likely be confused between two of the crowd and will have learned to carefully pick out one from the other. *Id.* No likelihood of confusion can exist between

Applicant's Mark and NU VERUS & Design, as the purchasers of NUTRIVERUS & Design are well educated and informed solely by independent distributors of a specifically designed multi-level marketing program and the marks exist with a large number of similar marks using the terms "NU" and "NUTRI".

The Examiners contention that Applicant's Mark is similar to NU VERUS & Design is also inconsistent with the United States Patent and Trademark Office's prior treatment of such marks. The Trademark Office has registered several marks that contain both "NU" and "NUTRI" that share a common word, just as Applicant's Mark and NU VERUS & Design both contain the "VERUS." See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005) (citing J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:88 (4th ed. 2001) ("[e]vidence of widespread third party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field"); *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed. Cir. 1986) ("[t]he record shows that a large number of marks embodying the words 'bed and breakfast' are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words 'bed and breakfast'"). The marks also have similar, if not identical, goods/services and these marks readily coexist in the marketplace without any likelihood of confusion. In the Final Office Action, the Examiner quotes: "However, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. Applicant respectfully disagrees and notes that the number and nature of

similar marks is actually part of the *du Pont* factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See du Pont* Factor No. 6 “The number and nature of similar marks in use on similar goods.” Thus, the Examiner cannot discredit the number and nature of similar marks used on similar goods that contain both “NU” and “NUTRI” along with a common shared word.

The practice of the Trademark Office in registering these marks underscores the fact that terms of Applicant’s Mark and NU VERUS & Design are dissimilar. Since all of these marks coexist (some of the demonstrated marks have coexisted over 20 years), it is possible for Applicant’s Mark and NU VERUS & Design to also peacefully coexist

V. CONCLUSION

Based on the foregoing submission and Applicant’s prior submissions responsive to the office actions, Applicant submits that any conclusion that there is a likelihood of confusion would be speculative and contrary to the record in this application as the cited mark, in its entirety is so decidedly different that no likelihood of confusion exists. Further, the sophistication of purchasers and nature and number of similar marks is such that no likelihood of confusion exists. Therefore, Applicant respectfully requests the Board reverse the Examiner’s refusals and approve the subject mark for publication.

Respectfully submitted,

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Date: February 16, 2016

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